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DM

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DEC 8 - 1995

Ex parte ATSUSHI SAITO, TAKESHI MAEDA
HISATAKA SUGIYAMA and WASAO TAKASUGI

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 95-1443
Application 07/757,911¹

ON BRIEF

Before HARKCOM, Vice Chief Administrative Patent Judge, and KRASS
and BARRETT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 39, constituting all the claims in this reissue application.

¹ Application for patent filed September 11, 1991. According to applicants, the Application is a Reissue of 07/085,964 filed August 17, 1987, now Patent No. 4,866,692 issued September 12, 1989.

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The invention is directed to an information recording and reproducing apparatus and method. This reissue application has been filed within two years from the issue date of U.S. Patent No. 4,866.692.

No representative claim is reproduced herein since a detailed description of the claimed features of the instant invention is not necessary, the sole issue on appeal being whether the reissue declarations of record are sufficient under 35 U.S.C. 251.

Claims 1 through 39 stand rejected under 35 U.S.C. 251 as being based on a defective reissue declaration as required by 37 CFR 1.175.

Rather than reiterate the arguments of appellants and the examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

We reverse.

In listing requirements for reissue declarations, 37 CFR 1.175(a) states the following:

...(1) When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing." particularly specifying such defects.

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(3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

As to (1), appellants do not assert that the original claims are in any way inoperative or invalid or that there are any problems with the original claims. In fact, original claims 1 through 18 are reasserted, intact, in this reissue application.

With regard to (2), there are no defects in the specification or drawing and, therefore, appellants do not specify that there are such defects.

Turning now to (3), appellants contend that the patent is inoperative or invalid by reason that they claimed more or less than they had a right to claim in the patent and present new claims 19 through 39 in addition to original claims 1 through 18.

The examiner takes the position that appellants have not distinctly specified the excess or insufficiency in the claims and have not shown how this reissue application overcomes the defect in the original patent. The examiner contends that appellants have merely restated the claim language in their reissue declaration and that this detailed listing of the claim language does not distinctly specify the excess or insufficiency in the claims.

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We disagree with the examiner. In the supplemental reissue declaration (Paper No. 7; October 5, 1992), appellants clearly specify the excess or insufficiency in the claims. For example, on page 4 of the supplemental reissue declaration, paragraph (a) points out how new claim 19 differs from original patent claims 1 through 18 in reciting the use of a predetermined code and pulse width setting means for correcting width of a pulse, a leading edge and a trailing edge of the pulse corresponding to "1" of the predetermined code and the relation of modulating means and reproducing means in relation to such predetermined code, features not recited in the original claims, while omitting features such as movement distance and/or a linear relationship and/or a non-linear relationship as recited in the original claims. The remainder of the supplemental declaration points out the differences between the other new claims and the original patent claims. Accordingly, appellants have specifically indicated what they consider to be the excess or insufficiency in the original claims in that while these original claims are valid and operative by themselves, appellants had a right to additional claims of a scope different from that of the original claims.

We note in passing that appellants' argument concerning communication with Patent and Trademark Office officials is unpersuasive. While appellants' representative(s) may have been told that the option of filing a continuation application was

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closed to appellants because of a lack of copendency in view of the issuance of U.S. Patent No. 4,866,692 and the filing of a reissue application may have been suggested, we doubt very much that such officials would have "already determined that an error has occurred in compliance with 35 USC 251..." [page 10 of the brief]. It goes without saying that each application is treated on its own merits and that the mere suggestion of filing a reissue application does not, per se, guarantee that the reissue declaration filed therewith will automatically be considered to be in compliance with 35 U.S.C. 251 without further examination.

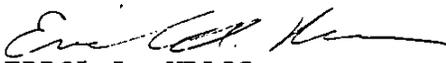
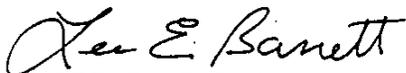
As our reviewing courts have consistently stated, the reissue statute is based on fundamental principles of equity and fairness and that, as a remedial provision, intended to bail applicants out of difficult situations into which they get without any deceptive intention, it should be liberally construed so as to carry out its purpose to the end that justice may be done to both patentees and the public. In re Oda, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971); In re Willingham, 48 CCPA 727, 282 F.2d 353, 127 USPQ 211 (1960).

It is our view that these principles of equity and fairness require a reversal of the rejection under 35 U.S.C. 251 in the instant case.

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The examiner's decision rejecting claims 1 through 39 is
reversed.

REVERSED


GARY V. HARKCOM, Vice Chief)
Administrative Patent Judge)
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ERROL A. KRASS)
Administrative Patent Judge)
)

LEE E. BARRETT)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
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